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09/649,400	08/26/2000	Joseph A. Herman	403-8	7185

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/649,400

Applicant(s)

HERMAN ET AL.

Examiner

Bradley Bayat, Esq.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1-10.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1, 2, and 4-6 have been amended and 11-21 was canceled in the response filed on 29 September 2004. Therefore, claims 1-10 are pending and again presented for examination on the merits.

### ***Response to Amendment***

The declaration executed on 7 January 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the cited reference.

The Kou reference is a U.S. patent that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings.

If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Kou reference to either a constructive reduction to practice or an actual reduction to practice. Applicant's exhibits individually and/or in combination fail to establish such diligence. For instance, the agenda of a conference (Exhibit H) fails to support a reduction to practice to overcome an effective filing date of the Kou reference.

***Response to Arguments***

Applicant's arguments with respect to claims 1-21 have been considered but are not persuasive.

The applicant contends that the amended claims overcome the cited Kou reference since access to the vendor's response communication is not restricted and "buyer's voluntary restraint is relied upon to assure that buyer doesn't access the substantive content until some time determined from the deadline (applicant's response page 5)." The applicant further contends "purchasing agents have pressured applicant to configure the system so that they hold as much control over the process in the electronic environment as they held in the paper environment (applicant's response page 6)." In addition, the applicant provides an emergency example wherein goods up for bid may be required prior to the end of the bid end date and as such the applicant can provide a mechanism similar to a paper bid wherein a bid is unsealed prior to auction end, violating rules of fair play.

As applicant has described in detail in the specification, the claimed invention is directed to an electronic sealed bid method that can ensure that all parties abide by the integrity of the sealed bid process (specification page 10). In fact, the applicant goes on to describe a deadline-integrity process that precludes access to messages or logs the online activity of the user to verify that integrity was intact after the auction end (Id.). Kou recognized the same limitations and integrity issues described in the instant application and provides for multiple scenarios and instances in overcoming them (column 3, lines 45-60). In fact, allowing access to such sealed bids while violating the rules of fair play as suggested by the applicant is contradictory to the hallmark of the sealed bid process as described by the applicant in the disclosure. The log

process described by applicant to effectuate verification after auction end fails to address the deficiencies described by the applicant during the auction process and requires post transaction verification, in contrary to the hallmark of a sealed bid transaction method. Therefore, it is the examiner's position that the mere fact that applicant is duplicating the paper bid process without restraint in an electronic environment does not overcome the Kou reference.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As per claim 1, the applicant states the phrase "without computer-implemented restraint" and "without buyer's discretion." It is unclear and vague from the language of the claim, how computer-implemented restraint is lacking. By definition, all computer-implemented interaction poses some limitation or restraint. Furthermore, it is unclear what the applicant is referring to as "buyer's discretion." The applicant must particularly point out what discretion the applicant is referring to; otherwise, the claim is rendered as indefinite. Moreover, intended use language "whereby" in claim 1 merely states the result of the limitation in the claim and adds nothing to the patentability or substance of the claim. [See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001). Since claims 2-10 depends from independent claim 1, claims 1-10 are rejected as described above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kou, U.S.**

**Patent 6,363,365 B1.**

As per claim 1, Kou discloses a method of transacting a sealed bid competition over the Internet, comprising the steps of: providing a buyer that is intending to purchase by a sealed bid competition with computer-implemented means for originating a "request for bid" communication that includes bid data as well as a parameter of deadline (column 5, lines 45-55); providing a plurality of vendors with access to the "request for bid" communication by means of the Internet (column 5, lines 56-63); providing those vendors which choose to respond by the deadline with computer implemented means for responding with "response" communications containing substantive content presumptively responsive to the "request for bid" communication (column 5, lines 63-67); providing the buyer with access to the "response" communications by means of the Internet; and providing a deadline-integrity process such that either the buyer is precluded from access to at least the substantive content of the "response" communications until the lapse of some time determined from the deadline or the buyer's activity with accessing at least the substantive content of the "response" communications is logged so that such log record can thereafter disclose if the buyer voluntarily restrained itself from accessing at least the

substantive content of the "response" communications until the lapse of some time determined from the deadline; whereby the integrity of the sealed bid competition as transacted over the Internet is upheld at least in part by said deadline-integrity process (column 6, lines 1-17).

As per claim 2, Kou discloses the method of claim 1, wherein: the deadline-integrity process comprises providing an intermediary Internet resource to which the responding vendors commit the "response" communications, such that the intermediary Internet resource can either (i) preclude the buyer's access to at least the substantive content of the "response" communications until the lapse of some time determined from the deadline or (ii) log the buyer's activity with at least the substantive content of the "response" communications so that such log record can thereafter disclose if the buyer voluntarily restrained itself from accessing at least the substantive content of the "response" communications until the lapse of some time determined from the deadline (fig 2, 3A and 3B and associated text re third party).

As per claim 3, Kou discloses the method of claim 2, wherein: the intermediary Internet resource comprises one or more Internet sites (fig 1 and associated text re third party authenticators).

As per claim 4, Kou discloses the method of claim 1, wherein: the computer-implemented means for responding includes encrypting the "response" communications such that decryption requires access to a specific decryption key; and the deadline-integrity process comprises providing a trusted party with said specific decryption key, such that said trusted party can either (i) preclude the buyer's access to said specific decryption key until the lapse of some time determined from the deadline or (ii) log the buyer's activity with said specific decryption key so that such log record can thereafter disclose if the buyer voluntarily restrained itself from

accessing said specific decryption key until the lapse of some time determined from the deadline (fig 2 and 3 and associated text re encryption/decryption).

As per claim 5, Kou discloses the method of claim 1, wherein: the trusted party comprises an intermediary Internet resource, which may include one or more Internet sites (fig 1 and associated text re third party authenticators).

As per claim 6, Kou discloses the method of claim 1, wherein: the computer-implemented means for responding includes encoding or compressing the "response" communications such that decoding or decompressing requires access to a specific decoding or decompressing object; and the deadline-integrity process comprises providing a trusted party with said decoding or decompressing object, such that said trusted party can either (i) preclude the buyer's access to said decoding or decompressing object until the lapse of some time determined from the deadline or (ii) log the buyer's activity with said decoding or decompressing object so that such log record can thereafter disclose if the buyer voluntarily restrained itself from accessing said decoding or decompressing object until the lapse of some time determined from the deadline (columns 6-8).

As per claim 7, Kou discloses the method of claim 6, wherein: decoding or decompressing objects can comprise any of passwords, algorithms, or hyper-link branches to an Internet address (column 2, line 28 – column 3, line 3).

As per claim 8, Kou discloses the method of claim 1, wherein: wherein the log record is committed to machines of the buyer's at the instance(s) of the buyer's accessing activities with respect to the "response" communications such that the log record is undesirably vulnerable to unauthorized deletion, corruption or other manipulation (column 5, lines 5-44).



As per claim 9, Kou discloses the method of claim 1, wherein: the "request for bid" communication is contained in one or more web pages (column 6, lines 20-26).

As per claim 10, Kou discloses the method of claim 1, wherein: the lapse of some time determined from the deadline means a time concurrent with or later than the deadline (column 3, lines 35-44).

*It is the examiner's position that applicant's amendments to the claims have not overcome the Kou reference and therefore the examiner has not recopied the amended claims to recite the rejection under Kou. Therefore, the non-final rejection is incorporated by reference. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

#### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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